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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,800	01/03/2007	Kiichiro Kato	24-033-TN	6498
23400 7590 12/30/2008 POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER VO, HAI	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 12/30/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/574,800

**Applicant(s)**

KATO ET AL.

**Examiner**

Hai Vo

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-7 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7 and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

***Election/Restrictions***

1. The 112 rejections of claim 7 are considered moot in view of the present amendment.
2. All of the art rejections have been withdrawn in view of the present amendment and response. None of applied references teach or suggest an adhesive tape wherein there are no gas-passing channels on the surface of the substrate opposite the pressure-sensitive adhesive layer.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 4-7 and 28-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to which surface of the substrate is referred not to have the gas-passing channels. Does Applicant want to convey the side of the substrate opposite the pressure sensitive adhesive layer? Additionally, it is confusing as to whether the side edges of the substrate are the same or different from the pressure-sensitive adhesive layer side of the substrate. The current phraseology is unclear as to how the gas-passing channels are arranged. The scope becomes unclear since it is not determinable what structure can fall within the scope of the claim. Various interpretation, including some radically different arrangements are possible but do not seem within the scope of the disclosed invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-7, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Flanigan et al (US 2003/0077423). Flanigan teaches an adhesive tape comprising a cap layer bonded to a pressure sensitive adhesive layer (figure 5D). The cap layer can be a structured backing film, a structured adhesive layer (paragraph 61). The gas-passing channels in the cap layer and penetrating passages in the adhesive layer are disposed aligned with one another (figures 5D and 6B). The adhesive

layer includes a foaming agent (paragraph 49). This at least implies that the adhesive layer is a foam layer. The deliverable substance contained within the channels can diffuse out of the channels and adhesive layers (paragraph 51). Likewise, the foamed adhesive layer must have an open cell structure so as to enhance the diffusion. The channels in the adhesive layer are thus constituted from the open cell foam material. Flanigan discloses the penetrating passages in the adhesive layer formed by laser processing or by patterning (paragraph 78). The width of the recess is from 20 to 80 microns (paragraph 58), the pitch of the recess is 70 microns, and the depth of the recess is 70 microns (figures 3, 13-15). Accordingly, Flanigan anticipates the claimed subject matter.

8. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flanigan et al (US 2003/0077423). Flanigan discloses the number of reservoirs per unit area of the adhesive layer or the cap layer from 5  $E+0.6/cm^2$  to  $1/cm^2$  (paragraph 59). Flanigan further teaches that the channels or the reservoirs can be of any shapes and dimensions (paragraphs 55-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the channels having the shape and dimensions as instantly claimed as dependent upon the intended application of the article, namely achieving the desired performance required for a particular application.
9. Claims 1, 4-6, 29 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious

over Reed et al (US 4,906,240). Reed teaches a wound dressing comprising a porous absorbent material 12 and a pressure sensitive adhesive layer 30 attached to the porous absorbent material (abstract, figures 1 and 2). The adhesive layer has a plurality of apertures 24 aligned with the macropores 14 of the absorbent material. The macropores read on the claimed recesses. There are no macropores on the surface of the absorbent material opposite the adhesive layer. The surface aperture density in the adhesive layer is about 5 to 15% (column 7, lines 5-10). This at least indicates that the occupancy of the macropores out of the adhesive layer side of the absorbent material is about 5 to 15%. The macropores have an average pore size of 20 microns (example 1). The opening in the adhesive layer thus has an average diameter of 20 microns in view of the process of making an apertured adhesive facing. Reed does not specifically disclose the apertures in the adhesive layer formed by laser processing or by patterning. However, it is a product-by- process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Reed is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If

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the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. In re Marosi, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Reed. Accordingly, Reed anticipates or strongly suggests the claimed subject matter.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/  
Primary Examiner, Art Unit 1794